UNITED STATES PATENT AND TRADEMARK OFFICE

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NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>31 March 2010</u>.

2a) ☒ This action is **FINAL**.　　　　2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-7 and 9-20</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-7 and 9-20</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All　b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claims 1-7 and 9-20 are pending.

Response to Amendment and Arguments

Applicant's amendments filed on 3/31/10 were fully considered. Any new objections/rejections made below were necessitated by applicant's amendments. Any objections/rejections not repeated for record below were withdrawn due to applicant's amendment.

Applicant's arguments filed on 3/31/10 directed at the amended claims were fully considered, but are not persuasive. Applicant argues that none of the art of record teaches or makes obvious "searching messages stored in a common storage area of a database to find messages for a first intended recipient by matching a first identifier with a message associated with the first identifier" and "maintaining the message in the common storage area of a database for dynamic retrieval by a second intended recipient". The examiner respectfully disagrees, because even by what applicant describe is taught by Choubey, this limitation appears to be taught by Choubey.

On page 9 of the response filed, applicant states that Choubey only stores an email in a common storage space if the email has multiple recipients and if the total storage space required is less than a predetermined threshold. Applicant states that Choubey does not store a message in a common storage area of a database together with all other messages stored in the database, such that all messages are stored in the common storage area. The examiner respectfully notes that nowhere in any of the claims is it required that all messages be stored in the common storage area. The only

requirement in the claim is that the messages which are searched are stored in the

common storage area. Applicant's claims do not prohibit use of both static and dynamic

message retrievals as done by Choubey. By applicant's own admission, in Choubey's

invention, when a message has multiple recipients, it is stored in a common storage

area. A reference message is then placed in each recipient's inbox and when a user

opens the reference message, the server opens the message having multiple

recipients, which is identified by a unique message id (col 3, lines 39-55 and col 4, lines

43-52). Since there could be multiple messages belonging to multiple recipients stored

in the common storage area, one skilled should appreciate that Choubey's invention

must utilize some form of searching which matches a message with an identifier

associated with the message. As such, Choubey teaches "searching messages stored

in a common storage area of a database to find messages for a first intended recipient

by matching a first identifier with a message associated with the first identifier". Further,

since any of the multiple recipients can open the message stored in the common

storage area by opening their respective reference email message (col 3, lines 39-55

and col 4, lines 43-52), Choubey also teaches "maintaining the message in the common

storage area of a database for dynamic retrieval by a second intended recipient".

Claim Objections

Claim 9 is objected to because of the following informalities: "the message" in

lines 8-9 of claim 9 should be "a message". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-7, 9-10, 12-14, and 16-20 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Janacek et al (US 6,684,248) in view of Poplawski et al (US

2003/0208441) in further view of Choubey et al (US 7,305,430).

Claims 1 and 20:

As per claim 1, Janacek discloses:

1. Associating, by a computer, for facilitating accesss to messages, a message with

   a first intended recipient by a first identifier (i.e. NuID or email address of the

   recipient as identified by the toEmail field in the table seen in column 13),

   wherein the message is stored for retrieval in a common storage area of a

   database (Fig 1, database 13; col 3, line 66-col 4, line 2; col 4, line 26-29; col 4,

   lines 46-60; col 6, lines 5-9; col 8, lines 42-51; and col 12, line 59-col 13, line 67).

   Note that the message database, i.e. CMMSg Database discussed in cited

   columns 12-13, is capable of holding messages that are addressed to a recipient

   identified by the toEmail field and messages that were also sent to other users

   identified by the ccEmail and bccEmail fields. This message database is used to

   store all messages. One skilled should appreciate that email messages could be

sent to a single user or multiple users, thus since Janacek's message database

is capable of keeping track of both types of messages, and his message

database is used to store all messages, his message database is used to store

both single-recipient and multiple-recipient messages in a common storage area.

2. Notifying, by the ocmptuer, the first intended recipient of the message stored in
   the database using a notification message (i.e. email message) generated by a
   processing device, wherein the notification message contains an address of or a
   link to a website, by transmitting the notification message to the first intended
   recipient (col 5, lines 7-12; col 8, lines 64-67; and col 10, lines 1-5).

3. Providing, by the computer, the website for the first intended recipient to view the
   message (col 5, lines 13-36).

4. Authenticating, by the computer, the first intended recipient using a second
   identifier associated with the intended recipient (col 5, lines 13-36; col 8, lines 3-
   17; and col 11, lines 20-24).

5. Searching, by the computer, the messages stored in the common storage area of
   the database to find the messages for the first intended recipient by matching the
   first identifier with a message associated with the first identifier (col 6, lines 15-18
   and 27-31; col 7, lines 22-64; col 8, lines 15-17; and col 10, lines 62-67).
   Messages that have not yet been processed are pre-processed by searching the
   messages for any messages having an email address which matches a particular
   recipient's email address.

6. Providing, by the computer, the message associated with the first identifier to the
    first intended recipient for display by the first intended recipient (col 5, lines 33-
    36).

Janacek does not disclose wherein in response to no second identifier
associated with the first intended recipient, the first intended recipient is prompted to
create or register a second identifier. However, Poplawski discloses of a message alert
system in which in response no second identifier (i.e. username and password)
associated with the first intended recipient, the first intended recipient is prompted to
create or register a second identifier (paragraphs 29 and 38-40; and Fig 5).

At the time applicant's invention was made, it would have been obvious to one
skilled in the art to modify Janacek's invention such that rather than automatically
creating a second identifier for the first intended recipient if there is no second identifier
associated with the first intended recipient, Janacek's invention instead prompted the
first intended recipient to create or register a second identifier. It would have been
obvious to do so because replacing the mechanism in which the second identifier is
created in Janacek's invention using the one used by Poplawski's invention is simple
substitution of one known element for another to obtain predictable results. Both
mechanisms accomplish the same end result of creating a second identifier.

Janacek also does not explicitly disclose the message being stored for dynamic
retrieval by the first intended recipient and maintaining, by the computer, the message
in the common storage area of the database for dynamic retrieval by a second intended

recipient. However, these limitations are disclosed by Choubey (col 3, lines 39-55 and

col 4, lines 27-52). Note that in Choubey's invention if a message has multiple

recipients (i.e. is intended for a first and second recipient), a single copy of the message

is stored in a common storage area and this single message is then dynamically

retrieved for both the first and second intentioned recipient. Note also that while

Choubey's invention stores a single copy of this shared message if the total storage

space needed to store a single copy of each recipient exceeds a specified vale,

Choubey does not limit what this size could be, thus one skilled having common sense

should appreciate that any size could be set, including such that a single copy is always

stored for shared messages no matter the size limit for storage.

At the time applicant's invention was made, it would have been obvious to one

skilled in the art to further modify Janacek's invention such that if the (particular)

message has multiple intended (customer) recipients, a single copy of the message is

stored in a common storage area for dynamic retrieval as per Choubey's teachings.

One skilled would have been motivated to do so because it would reduce data storage

requirements associated with the email message (Choubey: col 1, lines 57-61).

Claim 20 is directed towards a system which implements the method of claim 1

and is rejected for much the same reasons. Note that Janacek, Poplawski, and

Choubey's inventions are implemented using computers and a computer network, thus

a computer network communicating with a memory; a memory communicating with a

processor; and the processor, when executing a computer program is configured to

execute the method as recited in claim 1 is inherent to Janacek, Poplawski, and

Choubey's combination invention since all computers have a memory and processor

communicating with each other and the processor executing instruction to implement

one or more methods. Note also that Janacek, Poplawski, and Choubey's combination

invention are implemented on a computer network used to send and receive email

messages.

Claim 9:

Janacek discloses:.

1. Associating, by a computer for facilitating access to messages, a message and

   with a first identifier (i.e. NuID and/or email address of the recipient as identified

   by the toEmail field in the table seen in column 13) corresponding to a first

   intended customer recipient, wherein the first identifier includes an account

   number (col 4, line 48-col 5, line 6; col 7, lines 15-17; col 8, lines 15-17; and col

   13, lines 35-41—toEmail, ccEmail, and bccEmail), wherein the message is stored

   in a common storage area of a secured database (Fig 1, encrypted database 13;

   col 3, line 66-col 4, line 2; col 4, line 26-29; col 4, lines 46-60; col 6, lines 5-9; col

   8, lines 42-51; and col 12, line 59-col 13, line 67). *Note that the message*

   database, i.e. CMMSg Database discussed in cited columns 12-13, is capable of

   holding messages that are addressed to a recipient identified by the toEmail field

   and messages that were also sent to other users identified by the ccEmail and

   bccEmail fields. This message database is used to store all messages. One

   skilled should appreciate that email messages could be sent to a single user or

   multiple users, thus since Janacek's message database is capable of keeping

track of both types of messages, and his message database is used to store all

messages, his message database is used to store both single-recipient and

multiple-recipient messages in a common storage area. Message database 13 is

encrypted, thus is secure.

2. Notifying, by the computer, the first intended customer recipient of the message

   stored in the secure database storage system by an electronic mail generated by

   a processing device, wherein the electronic mail contains an address of or a link

   to a website, by transmitting the electronic mail to the first intended customer

   recipient (col 5, lines 7-12; col 8, lines 64-67; and col 10, lines 1-5).

3. Providing, by the computer, the secure website for the first intended customer

   recipient to view the message (col 5, lines 13-36).

4. Authenticating, by the computer, the first intended customer recipient to view the

   message at the secure website using a second identifier associated with the first

   intended customer recipient (col 5, lines 13-36; col 8, lines 3-17; and col 11, lines

   20-24). *One skilled should appreciate that websites that require log-in are*

   typically secure websites.

5. Searching, by the computer, the messages stored in the common storage area of

   the secure database for the first identifier to find the single-recipient message

   associated with the first identifier to be viewed by the first intended customer

   recipient (col 6, lines 15-18 and 27-31; col 7, lines 22-64; col 8, lines 15-17; and

   col 10, lines 62-67). *Messages that have not yet been processed are pre-*

processed by searching the messages for any messages having an email

address which matches a particular recipient's email address.

6. Providing, by the computer, the message associated with the first intended
   customer recipient to the first intended customer recipient (col 5, lines 33-36).

Janacek does not disclose wherein in response to no second identifier
associated with the first intended customer recipient, the first intended customer
recipient is prompted to create or register a second identifier. However, Poplawski
discloses of a message alert system in which in response to no second identifier (i.e.
username and password) associated with the first intended customer recipient, the first
intended customer recipient is prompted to create or register a second identifier
(paragraphs 29 and 38-40; and Fig 5).

At the time applicant's invention was made, it would have been obvious to one
skilled in the art to modify Janacek's invention such that rather than automatically
creating a second identifier for the first intended customer recipient if there is no second
identifier associated with the first intended customer recipient, Janacek's invention
instead prompted the first intended customer recipient to create or register a second
identifier. It would have been obvious to do so because replacing the mechanism in
which the second identifier is created in Janacek's invention using the one used by
Poplawski's invention is simple substitution of one known element for another to obtain
predictable results. Both mechanisms accomplish the same end result of creating a
second identifier.

Janacek also does not explicitly disclose maintaining, by the computer, the message in the common storage area of the secure database for dynamic retrieval by a second intended recipient. However, this limitation is disclosed by Choubey (col 3, lines 39-55 and col 4, lines 27-52). Note that in Choubey's invention if a message has multiple recipients (i.e. is intended for a first and second recipient), a single copy of the message is stored in a common storage area and this single message is then dynamically retrieved for both the first and second intentioned recipient. Note also that while Choubey's invention stores a single copy of this shared message if the total storage space needed to store a single copy of each recipient exceeds a specified vale, Choubey does not limit what this size could be, thus one skilled having common sense should appreciate that any size could be set, including such that a single copy is always stored for shared messages no matter the size limit for storage.

At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify Janacek's invention such that if the (particular) message has multiple intended (customer) recipients, a single copy of the message is stored in a common storage area of Janacek's secure database for dynamic retrieval as per Choubey's teachings. One skilled would have been motivated to do so because it would reduce data storage requirements associated with the email message (Choubey: col 1, lines 57-61).

Claim 2:

Janacek further discloses wherein the first identifier is an account number (col 4, line 61-col 5, line 1 and col 10, lines 62-67).

Claim 3:

Janacek further discloses wherein the second identifier is a combination of a user identification and a password (col 5, lines 13-36; col 8, lines 3-17; and col 11, lines 20-24).

Claims 5 and 12:

Janacek further discloses wherein the single-recipient message includes a message portion; and an attachment file in a format that is different from a format of the message portion (col 4, lines 48-56).

Claims 6 and 13:

Janacek further discloses a step of encrypting the website to view messages using an encryption method (col 8, lines 23-27). SSL uses encryption.

Claims 7 and 14:

Janacek further discloses wherein the encryption method is SSL (col 8, lines 23-27).

Claim 10:

Janacek further discloses wherein the message includes at least one of customer account information, a financial statement, a special offer, a response to an inquiry, and a transaction confirmation (col 4, lines 48-53; col 8, lines 64-67; and col 10, lines 7-16).

Claims 15 and 18:

Janacek, Choubey, and Poplawski disclose all the limitations of claims 1 and 9. Poplawski further disclose providing a second address of or link to a secure webpage

on the secure website, the secure webpage containing the message, after successfully

authenticating the intended (customer) recipient (paragraphs 10, 29, 44, and 46).

Claims 16 and 19:

Janacek, Choubey, and Poplawski disclose all the limitations of claims 1 and 9.

Janacek does not explicitly disclose wherein in response to the particular message/the

message having multiple intended (customer) recipients, a separate copy of the

(particular) message is not stored in the database for each intended (customer)

recipient. However, Choubey discloses the limitation (col 1, lines 55-61).

Claim 17:

Janacek further discloses wherein the second identifier is at least one of a user

identification, an email address, and a password (col 5, lines 13-36; col 8, lines 3-17;

and col 11, lines 20-24).

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Janacek et al (US 6,684,248) in view of Poplawski et al (US 2003/0208441) in further

view of Choubey et al (US 7,305,430) in further view of Fung et al (US 2002/0055909).

Claims 4 and 11:

Janacek does not explicitly disclose wherein the second identifier is/includes a

physical characteristic of the first intended (customer) recipient identifiable by a

biometric identification system. However, Fung discloses use of an identifier that is a

physical characteristic of the user that is identifiable by a biometric identification system
(paragraphs 148-149).

At the time applicant's invention was made, it would have been obvious to one
skilled in the art to modify Janacek's invention such that after a user is authenticated via
a password as the second identifier the first time, a biometric identification system was
used in place of the password as part of the second identifier as per Fung's teachings
according to the limitations further recited in claims 4 and 11. One skilled would have
been motivated to do so because a biometric identifier is more secure than a password
since it cannot be forgotten by the user.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is (571) 272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/
Primary Examiner, Art Unit 2435